

**REMARKS/ARGUMENTS**

Reconsideration of the application is respectfully requested for the following reasons:

Rejection of Claim 20 Under 35 U.S.C. §112, first paragraph

In respond to this rejection, Applicant has amended claim 20 in the manner suggested in the last sentence at the bottom of page 3 of the Official Action. Reconsideration of claim 20 is respectfully requested.

Because the amendment merely adopts a suggestion made by the Examiner, it is respectfully submitted that it does not raise new issues, and entry of the amendment is accordingly requested.

Rejection of Claims 1, 2, 5-12, 15, 16, 20-27, 30, 31, 33, 35, 40-47, 52-58, 63, 66 and 70 Under 35 U.S.C. §102(e)

Applicants respectfully traverse this rejection since Duphorne does not show every element of the claimed invention.

The method of Duphorne provides a user with a Caller ID-compatible email notification signal indicating that email addressed to the user is received at a remote email server associated with the user. The method comprises a step of transmitting a query signal to the remote email server, a step of transmitting, in response to the query signal, a preliminary email notification signal from the remote email server to a central office coupled to a public switched telephone network, a step of formatting the preliminary email notification signal into the Caller ID-compatible email notification

signal according to one or more parameter values, and a step of transmitting the Caller ID-compatible email notification signal from the central office to the user using the public switched telephone network.

There are a number of differences between the method of Duphorne and claimed invention:

- First, the method of Duphorne does not include the steps of filtering the identification information by a filtering device for stopping transforming the identification information into the transmission signal if the new mail corresponds with a plurality of set deletion conditions, transferring the transmission signal in conjunction with a first signal and a second signal to a non-portable receiving terminal and transforming the transmission signal back into the identification information.
- Second, Duphorne does not teach that the transmission signal is transformed from an identification information filtered by a filtering device for stopping transforming the identification information into the transmission signal if the new mail corresponds with a plurality of set deletion conditions.
- Third, Duphorne fails to teach a filtering device for suspending preliminary email notification signal in response to a plurality of set deletion conditions prior to formatting the preliminary email notification signal into the Caller ID-compatible email notification signal.

In summary, the system of the claimed invention comprises a filtering device, which stops transforming the identification information into the transmission signal if the electronic mail corresponds with some predetermined delete conditions, or transforms the identification information into the transmission signal if the electronic mail corresponds with some predetermined permission

conditions. Duphorne does not teach such a filtering device and, therefore, the teachings of Duphorne are insufficient to anticipate the claimed invention and withdrawal of the rejection is respectfully requested.

Rejection of Claims 3, 4, 13, 14, 28, 29, 48, 49, 59, 60, 71 and 73-83 Under 35 U.S.C. §103(a)

With respect to Claims 3, 4, 13, 14, 28, 29, 48, 49, 59, and 60, since the teaching of Duphorne actually fails to teach every element of the claimed invention, and the teaching of Ozaki also fails to disclose the elements which Duphorne fails to teach, the combination of Duphorne and Ozaki also fails to render the claimed invention unpatentable. According to MPEP § 2143.03, If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Whether considered individually or in any reasonable combination, the teachings of Duphorne and Ozaki fail to suggest all of the claim limitations. Therefore, the teachings of the citations are insufficient to render the claimed invention unpatentable and thus Claims 3, 4, 13, 14, 28, 29, 48, 49, 59, and 60 are patentable over Duphorne and Ozaki.

With respect to claim 71, and 73-83, the combination of Duphorne and Ozaki fails to suggest the steps of transferring a transmission signal from an electronic mail provider to a receiving terminal which is predetermined by a corresponding user of said electronic mail, and transferring an identification information of said electronic mail to said receiving terminal when a response message from said receiving terminal is received within a predetermined period.

With respect to claims 17, 32, 39 and 69, although Clayton

(U.S. 5,875,234) discloses that the UART format is typically used for Caller ID services and Huna teaches a switch device for controlling operation the receiving terminal respectively, since the independent claims are nonobvious under 35 U.S.C. 103, these dependent claims depending therefrom are nonobvious. The combinations of Duphorne and Clayton as well as Duphorne and Huna are not sufficient to render the claimed invention prima facie obvious.

Conclusion

In light of the above remarks to the claims, Applicant contends that the claimed invention is patentable thereover. Favorable consideration and expedited allowance of the claims are most respectfully requested.

Respectfully submitted,

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